

REMARKS

In the Office Action, the Examiner objected to the specification, and to claims 5 and 7 due to informalities. The Examiner rejected claims 1, 2, 10, and 12 under 35 U.S.C. § 102(e) as being anticipated by Ogawa et al. (U.S. Patent No. 6,784,474, hereafter "Ogawa"); and rejected claims 6-9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Ogawa in view of Nguyen et al. (U.S. Publication No. 2004/0092095 A1, hereafter "Nguyen"). The Examiner indicated that claims 3-5 and 13-14 are drawn to allowable subject matter, and that these claims would be allowable if rewritten in independent form. Applicant thanks the Examiner for the indication of allowable subject matter, but respectfully traverses the rejections.

With respect to the Amendments to the Claims, Applicant has amended claim 1 to more clearly set forth the nature of the present invention. Applicant also has amended claim 5 to correct a minor typographical error.

The Examiner objected to the specification and cited numerous errors on pages 3-12. Applicant submits the attached copy of the original specification, filed on September 9, 2003, in response to a request by the Examiner during a telephone conversation on May 1, 2005. Applicant thanks the Examiner for the courtesy extended during the telephone conversation.

During the telephone conversation, Applicant pointed out to the Examiner that the originally filed specification does not contain the errors alleged by the Examiner. The Examiner requested that Applicant supply a substitute specification. Applicant provides attached herewith a copy of the as-filed specification, and respectfully submits

that the attached copy is evidence that the specification does not contain the errors alleged by the Examiner. Perhaps the errors were introduced into the Examiner's copy of the specification by the USPTO scanning operation. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to the claims.

The Examiner objected to claims 5 and 7 due to informalities. Applicant has amended claim 5 as required by the Examiner. Applicants also provide copies of pages 14 and 15 of the originally filed above captioned application, which shows claim 7 in its entirety. Applicant respectfully submits that the attached copy of the originally filed application does not contain the Examiner alleged error. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claims 5 and 7.

The Examiner rejected claims 1, 2, 10, and 12 under 35 U.S.C. § 102(e) as being anticipated by Ogawa. In order to support a rejection under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully traverses the rejection, as the cited reference does not teach each and every element of independent claim 1.

Claim 1 recites “a guard ring buried in said second insulating film surrounding said MIM capacitor; wherein said guard ring is provided such that said guard ring is electrically insulated from said first wiring, said second wiring, and said MIM capacitor.”

The Examiner contends that Oswaga discloses in FIG. 1A "a guard ring 40," which corresponds to Applicant's claimed guard ring. Office Action at 4.

Applicant respectfully disagrees with the Examiner's contention. Even assuming *arguendo* that the conductor sidewall 40 taught by Oswaga corresponds to the claimed guard ring, the conductor sidewall 40 taught by Oswaga is in contact with the upper electrode extension 35b, and upper electrode extension 35b is connected to upper electrode 35a of the MIM capacitor. Accordingly, Oswaga does not teach or suggest, "a guard ring . . . surrounding said MIM capacitor, wherein said guard ring is provided such that said guard ring is electrically insulated from said first wiring, said second wiring, or said MIM capacitor," as recited in amended claim 1, and therefore claim 1 is allowable.

In addition, claims 2, 10, and 12 depend from claim 1, and are allowable at least due to their respective dependencies. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(e).

The Examiner rejected claims 6-9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Ogawa in view of Nguyen. Applicants respectfully traverse the rejection under 35 U.S.C. § 103 as the cited prior art fails to teach each and every element recited in the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined)

must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j).

Claims 6-9 and 11 depend from claim 1, and thus include every limitation recited in claim 1. Claim 1 is allowable over Ogawa for at least the above discussed reasons. Nguyen is drawn to a "pre-liner and liner . . . deposited over the sidewalls of an opening." Col. 2, paragraph [0021]. Nguyen is silent with respect to "a guard ring . . . surrounding said MIM capacitor, wherein said guard ring is provided such that said guard ring is electrically insulated from said first wiring, said second wiring, or said MIM capacitor," as recited in claim 1. Therefore, Nguyen fails to correct the deficiencies of Ogawa in this regard, and the cited prior art, neither alone nor in combination, teaches or suggests each and every element of claim 1. Thus, claims 6-9 and 11 are allowable at least due to their dependence from claim 1. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a).

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Application No.: 10/657,119
Attorney Docket No. 09108.0003-00

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 9, 2005

By: Charles E. Van Horn #40,266
for Richard V. Burgujian
Reg. No. 31,744

Attachments: Copy of specification as-filed (pages 1-15).